

REMARKS

This Amendment is in response to the Office Action dated 12/22/2005. Claims 1-16, 21 and 22 were rejected under 35 U.S.C. § 103(a).

Claims are amended as shown above. Specifically, independent claims 1 and 11 are amended to more clearly recite features of the claimed invention. Claims 1, 2-16, 21, and 22 are now pending in the application. For the reasons set forth below, the Applicants respectfully request reconsideration and allowance of all pending claims.

CLAIM REJECTIONS - 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, there must first be some suggestion or motivation to modify a reference or to combine references, and second be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j) from *In Re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed device; and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the Applicants' disclosure. *Amgen v. Chugai Pharmaceutical*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991), *Fritsch v. Lin*, 21 USPQ2d 1731 (Bd. Pat. App. & Int'f 1991). An invention is non-obvious if the references fail not only to expressly disclose the claimed invention as a whole, but also

to suggest to one of ordinary skill in the art modifications needed to meet all the claim limitations. *Litton Industrial Products, Inc. v. Solid State Systems Corp.*, 755 F.2d 158, 164, 225 USPQ 34, 38 (Fed. Cir. 1985).

The examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. M.P.E.P. § 70602(j) from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Obviousness cannot be established by combining references without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. M.P.E.P. § 2144 from *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) (emphasis added by M.P.E.P.).

A disclosed embodiment of the invention will now be discussed in comparison to the applied reference(s). Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and the subject matter described in the applied reference(s), do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

The Hollander et al. reference (US 6,172,645) describes a PCMCIA modem card that utilizes an integrated, extendable antenna for wireless transmission and reception. Hollander contemplates that when the antenna structure 22 is in operation, it is slid out of the opening 18 of the modem card 10. (Col. 6, ll. 4-8). To protect the antenna structure 22 when not in use, the antenna structure 22 is retracted back into the cavity 16 of the modem card. (Col. 6, ll. 8-12). However, Hollander fails to describe the functionality provided by the current application. This reference describes the extension and retraction as a way of conveniently protecting and storing the antenna when the antenna is not being used. However, the reference does not teach the functionality described by the Applicants' claimed invention whereby a communications

module is automatically disabled when an antenna is retracted into the cavity while the portable device remains operable.

The Kaschke reference (US 5,898,933) discloses a radio telephone 200 having an antenna 213 to provide wireless transceiving communications between phone 200 and a cellular radiotelephone system. (Col. 3, ll. 51-67). Antenna 213 may be extended or retracted to/from phone 200 depending on whether phone 200 is in use. Phone 200 is configured for enabling or disabling a predetermined operating mode responsive to antenna's 213 position. (Col. 4, ll. 5-13).

Extending antenna 213 may ready phone 200 to answer a telephone call or ready the phone to make a call; this is referred to by Kaschke as enabling an "off-hook" mode. (Col. 5, ll. 3-8). The user may terminate a telephone call by retracting antenna 213. Such a retracted state of the antenna is referred to as an "on-hook" state. (Col. 5, ll. 14-19). The "on-hook" and "off-hook" terms are derived from the state of a hand set in conventional telephones. That is, when the hand set is resting on the base portion, the telephone is "on-hook" whereby the telephone is in a mode operative to end a call or receive a call but not to transmit a call. Moreover, when the hand set is removed from the base portion, the telephone is "off-hook" whereby the telephone is in a mode operative to transmit a call but not receive a call. In either position, a communication module associated with phone 200 is not disabled. Rather, the "on-hook" state or "off-hook" state relate to enabling or disabling a particular operational mode of a communication module. (Abstract).

By way of contrast, Applicant's independent claims, for example, claim 1 recite an apparatus comprising:

wherein the antennae unit is adapted to disable the communication module when in a first position and wherein the apparatus is operable when the antennae unit is in the first position.

Respectfully, Kaschke fails to teach or suggest “disabling a communication module” as recited in claim 1 or related limitations recited in the remaining dependent claims. Since Kaschke only discloses changing modes of operation in response to the antenna position and not disabling a communication module as recited in claims 1, 2-16 and 21-22, Kaschke does not disclose or suggest the subject matter of Applicant’s claims.

Individually, the Hollander and the Kaschke references fail to teach the functionality disclosed by the applicant’s invention. Therefore a combination of these references also fails to teach or suggest what is recited in this invention.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, independent claims 1 and 11 are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned agent has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned agent at (480) 715-3787.

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Respectfully submitted,

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